REMARKS

Claims 1-43 are currently pending in the application. Claims 1, and 32-33 have been amended. Claims 2-31 remain unchanged. Claims 34-43 are new. Applicants thank the Examiner for the indication of allowability with respect to claims 21-23.

I.   112 Rejection

Claims 1-33 have been rejected under 35 U.S.C. § 112 as being indefinite. Claims 1, 32, and 33 have been amended to remove the "can be" term. The amendments serve to clarify the claim scope and not to further limit or narrow the scope of the claim.

II.   103 Rejection

A.   Claims 1-6, 13-17, 20, 24, 32-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,241,648 issued August, 31 1993 to Cheng et al. (hereafter Cheng) in view of U.S. Patent No. 4,905,138 issued February 27, 1990 to Borne (hereafter Borne) and further in view of the document entitled IBM "SQL Reference".

1.   Applicants initially note that the SQL Reference document does not include a publication date and was apparently retrieved from an internet site. Applicants further note that according to MPEP 2128, an internet publication cannot be relied upon as prior art if the publication does not include a publication date or retrieval date. As such, it is respectfully submitted the rejection cannot be maintained using any combination of documents which include the SQL Reference document.

2.   Regarding the substance of the Office Action's rejection, the Office Action asserts that combination of Cheng, Borne, and the SQL Reference documents disclose each and every limitation of the claimed invention, and that one skilled in the art would have been motivated to make this combination. Applicants respectfully disagree. Applicants submit that there is no suggestion or motivation to make the stated combination.

It is noted that the pending claims are directed towards a method, system, and program product for _pipelining_ a table function. Applicants respectfully note that the Cheng et al. reference cannot be used in any system that employs pipelining, and that it would render Cheng unsatisfactory for its intended purpose and inoperable to use the Cheng technology for pipelining of a table function.

The hybrid join technique of the Cheng reference joins two tables of relational data base management systems in a three-stage process. Cheng explicitly states that this solution _requires an index to exist_ on one or more of the join columns of the inner table when the join predicates are combined by ANDing _or that indexes on each join column of the inner table exist_ where index ANDing or ORing can be performed to achieve the result of an index on all join columns (See Col. 4, lines 40-65). In fact, Cheng requires _staging_ of data during this process ("At the end of this stage, _a temporary work table_ containing the selected inner table RID's concatenated to their matching outer table rows is produced" - col. 5, lines 7-9).

In other words, Cheng _requires staging and indexing_ of data before it can be used. Without staging the data, the required index of Cheng cannot be formed, rendering Cheng inoperable. As such, Cheng cannot be used in any approach that implements pipelining, which does not utilize staging of data.

MPEP 2143.01 explicitly notes that there cannot be a motivation or suggestion to make a proposed modification if the proposed modification would render the prior art being modified unsatisfactory for its intended purpose. Since the proposed modification would render Cheng inoperable and unsatisfactory for its intended purpose, Applicants respectfully submit that there is no motivation to combine Cheng with the other cited documents to achieve the claimed invention that recites pipelining. Since neither Borne nor the SQL Reference makes up for the deficiencies of Cheng, it is respectfully submitted that claims 1-43 are allowable over these cited documents.

B.   Claims 7-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,241,648 issued August, 31 1993 to Cheng et al. (hereafter Cheng) in view of U.S. Patent No. 4,905,138 issued February 27, 1990 to Borne (hereafter Borne) and the document entitled

IBM "SQL Reference", further in view of U.S. Patent No. 6,052,699 issued April 18, 2000 to Huelsbergen et al. (hereafter Huelsbergen).

1.   As noted above, the SQL Reference document does not include a publication date and was apparently retrieved from an internet site, and therefore it is respectfully submitted that the rejection cannot be maintained using any combination of documents which include the SQL Reference document.

2.   Even if the SQL Reference document sis considered, there is no motivation or suggestion to form a combination using Cheng that is directed to pipelining, since such a combination would render Cheng inoperable for its intended purpose. Heulsbergen does not make up for the deficiencies of the combination. The Heulsbergen reference provides a garbage collection technique for the concurrent operation of a mutator and garbage collector (e.g., marker and sweeper) without requiring fine-grain synchronization or atomicity amongst the mutator, marker and sweeper. In accordance with the Huelsbergen reference, three threads are used for concurrently executing the mutator, marker and sweeper. As such, Cheng, Bourne, SQL Reference, and Huelsbergen, neither alone, nor together, disclose, teach, or suggest the limitations in claim 7-10 which depends on claim 1 and cannot be used to preclude patentability of those claims under 35 U.S.C. § 103.

C.   Claims 11, 12, 18, and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,241,648 issued August, 31 1993 to Cheng et al. (hereafter Cheng) in view of U.S. Patent No. 4,905,138 issued February 27, 1990 to Borne (hereafter Borne) and the document entitled IBM "SQL Reference", further view of U.S. Patent No. 5,241,648 issued 25 April 1995 to Danneels et al. (hereafter Danneels). As shown above, the combination Cheng, SQL Reference, and Bourne cannot render the pending claims obvious. Danneels does not cure this deficiency.

1.   As previously noted, the SQL Reference document does not include a publication date and was apparently retrieved from an internet site, and therefore it is respectfully submitted that the rejection cannot be maintained using any combination of documents which include the SQL Reference document.

2.   Even if the SQL Reference document sis considered, there is no motivation or suggestion to form a combination using Cheng to is directed to pipelining, since such a combination would render Cheng inoperable for its intended purpose. Daneels does not make up for the deficiencies of the combination. The Daneels reference is a method and system for loading a library requested by a service requester of an application program in a computer system. The system comprises a first loader module and a second loader module. The first loader module receives a request from the service requester to load the library, where the first loader module is part of the executable application program. The second loader module receives the request from the first loader module and loads the library, where the second loader module is an executable distinct from the executable application program. As such, Cheng, Bourne, SQL Reference, and Daneels, neither alone, nor together, disclose, teach, or suggest the limitations in claim 11, 12, 18, and 19 which depends on claim 1 and cannot be used to preclude patentability of those claims under 35 U.S.C. § 103.

D.   Claims 25-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng, Bourne, and SQL Reference in further view of U.S. Patent No. 4,803,613 issued 7 February 1989 to Kametani et al. (hereafter Kametani). As shown above, Cheng, Bourne, and SQL Reference do not disclose, teach, or suggest all the limitations in amended claim 1, and there is no suggestion or motivation to make this combination. Kametani does not cure this deficiency.

An object of the Kametani solution is to provide a general-purpose control apparatus which has a high degree of flexibility and expansibility. Another object of the Kametani solution is to provide a hierarchical multiple controller system which has a high degree of flexibility and expansibility. A further object of the Kametani solution is to provide a decentralized control apparatus provided with a plurality of intelligent slave modules and a host processor for supervising the plane modules wherein the control process by the apparatus advances under the leadership of the slave modules. As such, it is respectfully submitted that Kametani does not make up for the deficiencies previously noted in the combination of Cheng, Bourne, SQL Reference documents.

For at least the same reasons as expressed above, Cheng, Bourne, SQL Reference, and Kametani, neither alone, nor together, disclose, teach, or suggest the limitations in claim 1 on which claims 25-28 depend, and there is not suggestion or motivation to make this combination; therefore these references cannot be used to preclude patentability of these claims under 35 U.S.C. § 103.

E.   Claims 29-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng, Bourne, and SQL Reference in further view of U.S. Patent No. 5,937,415 issued 10 August 1999 to Sheffield et al. (hereafter Sheffield). As shown above, Cheng, Bourne, and SQL Reference do not disclose, teach, or suggest all the limitations in amended claim 1, and there is no suggestion or motivation to make this combination. Sheffield does not cure this deficiency.

The Sheffield solution describes a Client/Server Database System with improved methods for performing data transfers. The system includes one or more Clients (e.g., Terminals or PCs) connected via a Network to a Server. In general operation, Clients store data in and retrieve data from one or more database tables resident on the Server by submitting SQL commands, some of which specify "queries"--criteria for selecting particular records of a table. As such, it is respectfully submitted that Sheffield does not make up for the deficiencies previously noted in the combination of Cheng, Bourne, SQL Reference documents.
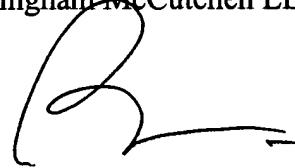
For at least the same reasons as expressed above, Cheng, Bourne, SQL Reference, and Sheffield , neither alone, nor together, disclose, teach, or suggest the limitations in claim 1 on which claims 29-31 depend, and there is not suggestion or motivation to make this combination; therefore these references cannot be used to preclude patentability of these claims under 35 U.S.C. § 103.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of the claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Bingham McCutchen's Deposit Account No. **50-2518,** referencing billing number **7011412001**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Bingham McCutchen's Deposit Account No. **50-2518,** referencing billing number **7011412001**.

Respectfully submitted,

Bingham McCutchen LLP

Dated: <u>December 1, 2005</u>   By: _____

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